REMARKS

Claims 1-27 are pending in this application. For purposes of expedition, claims 1, 3 and 15 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections, in accordance with current Office policy, to further define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

Claims 1-7 have been rejected under 35 U.S.C. §101 for reasons stated on pages 2-3 of the Office Action (Paper No. 01042006). Specifically, the Examiner alleges that base claim 1 merely claims non-functional descriptive material recorded on a readable medium, which is not statutory under 35 U.S.C. §101. On page 2 of the Office Action (Paper No. 01042006), the Examiner further asserts that the previously amended claim shows "intended use ... but lacks the functional correlation with a computer system, necessary to overcome the 101 rejection." In response thereto, base claim 1 has been amended to specify the functional correlation between the information recorded on a recording medium and an apparatus used to identify at least the copyright owner of the original content and the maker of the remake content. As amended, Applicants believe that the rejection should be withdrawn.

Claims 1, 6, 8, 9, 11-13 and 15 have been rejected under 35 U.S.C. §102(b) as being anticipated by newly cited art, Katz et al., U.S. Patent No. 5,926,624 for reasons stated on pages 4-6 of the Office Action (Paper No. 01042006). In support of the rejection of Applicants' base claim 1, the Examiner asserts that Katz '624 discloses,

> "a remake content based on at least one original content; (Katz, Col. 6 Lines 47-50, selected preview clips) and copying right information corresponding to the remake content, the copyright information including original copyright information to identify at least a copyright owner of the original content and remake copyright information to identify at least a maker of the remake content (Katz, Col. 6 Lines 55-61)."

However, the Examiner's assertion is factually incorrect. Applicants submit that these features of Applicants' base claim 1 are **not** disclosed or suggested by Katz '624 in the manner suggested by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

Base claim 1, as amended, clearly defines a recording medium which comprises two types of information: (1) remake content based on at least one original content, as shown in FIG.

1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (b) remake copyright information which, when processed by an apparatus, causes the apparatus to identify at least a maker of the remake content, as shown in FIG. 4. This way the copyright of the original content can be advantageously protected, while the personal use rights of an individual user on the original content can be guaranteed.

In contrast to Applicants' base claim 1, Katz '624 discloses a computer network based digital information library system, as shown in FIG. 2, in which a client computer system 214 or a mobile playback system 212 at a client site 210 can access a library server 260 for an indexed collection of digital information obtained from different sources, such as books, daily news, entertainment feeds, conferences and educational sources, via a distribution network 240 at a library site 250.

At the library site 250, an authoring system 280 is used to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260. Such an authoring system 280 can also be used to partition digital information content into segments, which can be identified, searched, and skipped over if desired. As shown in FIG. 3, the authoring system 280 contains a preview generator 232 which generates preview clips 324 for providing short pre-generated portions of digital information content used to give a consumer a sense of the content of a particular digital information file. As further described on column 6, lines 42-68 of Katz '624,

> "[T]he raw digital information content 310 is also fed to template header generator 312. Each digital information file maintained by the library server 260 includes other descriptive information used to identify the file's content and to provide information used to process the digital information within the file. **Each digital information file includes a template header**, a descrambling map, selected preview clips, and the digital information programming itself. In the preferred embodiment, the template header comprises a number of attributes corresponding to the digital information in the file. For example, the digital information may be audio information generated from the content of a book or other published work. In this example, the audio file template header contains attributes including: 1) the title of a book, volume, or medium from which the digital information content originated, 2) the legal copyright associated with the digital information content, 3) audible title(s) of the content, 4) a table of contents of the content, and 5) playback settings for appropriately playing or rendering the digital information. The table of contents contains content navigation information including but not limited to: the number of chapters, the length of the program, and information indicative of the relevant content sections. The table of contents

is generated with input from authoring system operator 305 or automatically by analysis of digital information content 310."

However, there is **no** disclosure from Katz '624 of Applicants' efforts to record on a recording medium: (1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (b) remake copyright information which, when processed by an apparatus, causes the apparatus to identify at least a maker of the remake content, as shown in FIG. 4, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in Applicants' base claim 1.

Nevertheless, the Examiner cites column 6, lines 55-61 of Katz '624 for allegedly disclosing "the copyright information corresponding to the remake content ... including original copyright information to identify at least a copyright owner of the original content, and remake copyright information to identify at least a maker of the remake content." However, the Examiner's citation is misplaced.

The cited column 6, lines 55-61 of Katz '624 only refers to the use of a file header in each digital information file for storage in a library server260, including attributes, such as, for example, the legal copyright associated with the original content, i.e., a digital information file. There is **no** disclosure or suggestion anywhere in Katz '624 of Applicants' claimed "remake copyright information used to identify at least a maker of the remake content" as expressly defined in Applicants' base claim 1.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Katz '624 fails to disclose and suggest key features of Applicants' base claim 1 and its dependent claim 6. Therefore, Applicants respectfully request that the rejection of claims 1 and 6 be withdrawn.

Likewise, in support of the rejection of Applicants' base claim 8, the Examiner asserts that Katz '624 discloses,

> "making a remake content based on at least one original content (Katz, Col. 6 Lines 47-50, Selected preview clips), recording the remake content on the recording medium (Katz, Col. 8 Lines 32-42, transfer to client computer) and generating and recording copyright information corresponding to the remake content on the recording medium, the copyright information including original copyright information to identify at least a copyright owner of the original content and remake copyright information to identify at least a maker of the remake content on the recording medium (Katz, Col. 6 Lines 55-61)."

Again, as previously discussed, the Examiner's assertion is factually incorrect. Contrary to the Examiner's assertion, the cited column 6, lines 55-61 of Katz '624 only refers to the use of a file header in each digital information file for storage in a library server260, including attributes, such as, for example, the legal copyright associated with the original content, i.e., a digital information file. There is **no** disclosure or suggestion anywhere in Katz '624 of Applicants' claimed "remake copyright information used to identify at least a maker of the remake content" as expressly defined in Applicants' base claim 8.

Similarly, in support of the rejection of Applicants' base claim 15, the Examiner also asserts that Katz '624 discloses,

> "a converting unit to convert at least one original content into a remake content (Katz, Fig. 3 Item 323), a processor to generate copyright information including original copyright information on the original content and remake copyright information including identification information relating to said apparatus

on the remake content (Katz, Col. 6 Lines 23-30 and Lines 55-61), and a recording unit to record the remake content obtained by the converting unit, the identification information and the copyright information generated by the processor on a recording medium (Katz, Col. 8 Lines 32-42, transfer to client computer."

Again, the Examiner's assertion is also factually incorrect. Contrary to the Examiner's assertion, the authoring system 280 of Katz '624 is **not** and can**not** be interpreted to read on Applicants' claimed "processor to generate copyright information including original copyright information on the original content and remake copyright information including identification information relating to said apparatus on the remake content" as defined in Applicants' base claim 15. As previously discussed, such an authoring system 280 is only used at a library site 250 to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260. Moreover, the information transferred to a client computer 214 at a client site 210 does **not** include any remake copyright information as alleged by the Examiner.

In view of the foregoing reasons, and the noted deficiencies of Katz '624, Applicants respectfully request that the rejection of claims 1, 6, 8, 9, 11-13 and 15 under 35 U.S.C. §102(b) be withdrawn.

Dependent claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624, in view of Fuchigami et al., U.S. Patent No. 5,960,398. According to the Examiner, Fuchigami '398, as a secondary reference, is cited for allegedly suggesting the use of a copyright embedding apparatus for managing copyrights in a storage medium. However, the rejection is improper because, even if Fuchigami '398 is incorporated into the computer network based digital information library and delivery system as disclosed by Katz '624, the proposed incorporation still does not arrive at Applicants' claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26. This is because Fuchigami '398 only discloses a copyright information embedding system, as shown in FIG. 1, in which copyright information for copyright protection can be embedded into digital audio signal without deterioration of analog audio reproduced. As acknowledged on column 1, lines 44-48 of Fuchigami '398, conventional system used to embed copyright data into digital data has the drawback in that digital-to-analog (D/A) conversion of the digital data into analog audio data would cause reproduced sound quality to be deteriorated or changed uncomfortably. Like Katz

'624, Fuchigami '398 does **not** disclose or suggest Applicants' efforts to reproduce from a recording medium: 1) remake content based on at least one original content, as shown in FIG. 1; and 2) copyright information, as shown in FIG. 1, that has both (a) original copyright information on the original content, and (b) remake copyright information on the remake content, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in the base claims.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. Furthermore, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Katz '624 and Fuchigami '398 fail to disclose and suggest key features Applicants' claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26. Therefore, Applicants respectfully request that the rejection of claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26 be withdrawn.

Dependent claims 17, 18, 24, 25 and 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz '624, in view of Bersson, U.S. Patent No. 6,081,897 for reasons listed on pages 10-12 of the Office Action (Paper No. 01042006). Lastly, dependent claim 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz '624 and Bersson '897, as applied to claims 17, 18, 24 and 27, an in further view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 12-13 of the Office Action (Paper No. 01042006). Since these rejections are predicated upon the correctness of the rejection of their respective parent claims, Applicants respectfully traverse these rejections primarily based on the same reasons discussed against the rejection of their respective parent claims.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at

the Washington DC office at (202) 216-9505 ext: 232. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

INTERVIEW:

In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. attorney at the local Washington, D.C. telephone number (202) 216-9505 ext. 232 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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